

REMARKS

This is in response to the Office Action mailed on September 1, 2004, and the references cited therewith.

No claims are amended, canceled or added; as a result, claims 1-34 are now pending in this application.

§103 Rejections of the Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Rejection of claims 1, 3-4, 7-9, 13, 15-16, 19-21, 23, 25-26, and 29-31 over Barts et al.:

In item 3 of the Office Action, claims 1, 3-4, 7-9, 13, 15-16, 19-21, 23, 25-26, and 29-31 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Barts et al. (U.S. 2002/0082893). Applicant respectfully traverses the rejection.

With respect to claims 1, 13, and 23, the Office Action states that Barts et al. teaches:

- "retrieving listing identification data from a user" (claim 1)
- "retrieving listing identification data from a user requiring posting of a listing on a network-based commerce system" (claims 13 and 23)
- "retrieving listing data associated with the listing based on the listing identification data" (claims 1, 13, and 23), and
- "generating a listing at least partially based on the listing data" (claims 1, 13, and 23).

Applicant respectfully disagrees. Barts et al. teaches a product delivery system for automobiles (Abstract). A user may enter a vehicle identification number (VIN) into a screen

(Fig. 25), and the system may retrieve vehicle information (Figs. 26 and 27, and p. 29, paragraph [0577] through p. 30, paragraph [0617]) The purpose of the system of Barts et al. is to enable a user to track the location of a vehicle (e.g., a dealer may track the location of a vehicle ordered by the dealer). Nowhere do Barts et al. disclose the concept of a listing, as claimed in Applicant's claims 1, 13, and 23, and claims that depend therefrom. Accordingly, Applicant respectfully submits that Barts et al. do not disclose the above-listed features of Applicant's claims.

Further, the Office Action rejected claims 1, 3-4, 7-9, 13, 15-16, 19-21, 23, 25-26, and 29-31 based only on Barts et al. The Office Action stated that not all of the recited elements of the claims are found Barts et al., and more specifically that "Barts does not explicitly teach the claimed limitation 'and posting the listing on the network-based commerce system' " (rejection of claim 1) or "the claimed limitation 'and post the listing on the network-based commerce system' " (rejection of claims 13, 23). The Office Action goes further to state that: "However, Barts teaches displaying the result to a user (fig. 27)," and that "[i]t would have been obvious to a person of an ordinary skill in the art at the time the invention was made to apply Barts' teaching of displaying the result to a user in order to allow a user [to] view/read a result quickly."

"Displaying the result to a user" is not the same as the identified missing element of Applicant's claims of "to post (or posting) the listing on the network-based commerce system." Accordingly, the Office Action does not make a viable argument that the Barts et al. reference teaches or suggests all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Again, the Office Action has identified a missing element from claims 1, 13, and 23 as "to post (or posting) the listing on the network-based commerce system." Applicant assumes that the Examiner is taking official notice of the missing element. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of official notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Claims 3-4, 7-9, 15-16, 19-21, 25-26, and 29-31 depend, directly or indirectly, on claims 1, 13, and 23, respectively, and are patentable over Barts et al. for the reasons argued above, plus the elements in the claims. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 1, 3-4, 7-9, 13, 15-16, 19-21, 23, 25-26, and 29-31 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 2, 14, and 24 over Barts et al. in view of Johnson:

In item 4 of the Office Action, claims 2, 14, and 24 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Barts et al. in view of Johnson (U.S. 2002/0083448). Applicant respectfully traverses the rejection.

The Office Action states that “Barts discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1, 13, and 23, Applicant submits that Barts et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 2, 14, and 24 depend, respectively.

In addition, Applicant submits that the combination of Barts et al. and Johnson does not produce the subject matter of claims 2, 14, and 24. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Barts et al. and Johnson references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991))

Further, there is not suggestion or motivation given for combining the Barts et al. and Johnson references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office

Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 2, 14, and 24 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 5-6, 17-18, and 27-28 over Barts et al. in view of Erdelyi:

In item 5 (page 5) of the Office Action, claims 5-6, 17-18, and 27-28 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Barts et al. in view of Erdelyi (U.S. 6,631,522). Applicant respectfully traverses the rejection.

The Office Action states that “Barts discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1, 13, and 23, Applicant submits that Barts et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 5-6, 17-18, and 27-28 depend, respectively.

In addition, Applicant submits that the combination of Barts et al. and Erdelyi does not produce the subject matter of claims 5-6, 17-18, and 27-28. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Barts et al. and Erdelyi references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Barts et al. and Erdelyi references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 5-6, 17-18, and 27-28 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 10-12, 22, and 32-34 over Barts et al. in view of Ortega et al.:

In item 5 (page 7) of the Office Action, claims 10-12, 22, and 32-34 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Barts et al. in view of Ortega et al. (U.S. 6,410,084). Applicant respectfully traverses the rejection.

The Office Action states that “Barts discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1, 13, and 23, Applicant submits that Barts et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 10-12, 22, and 32-34 depend, respectively.

In addition, Applicant submits that the combination of Barts et al. and Ortega et al. does not produce the subject matter of claims 10-12, 22, and 32-34. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Barts et al. and Ortega et al. references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Barts et al. and Ortega et al. references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that

the rejection of claims 10-12, 22, and 32-34 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 1, 3-4, 7-8, 10, 13, 15-16, 19-20, 22-23, 25-26, 29-30 and 32 over Sherr et al:

In item 6 of the Office Action, claims 1, 3-4, 7-8, 10, 13, 15-16, 19-20, 22-23, 25-26, 29-30, and 32 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Sherr et al. (U.S. 2002/0154157). Applicant respectfully traverses the rejection for several reasons.

With respect to claims 1, 13, and 23, the Office Action states that Sherr et al. teaches:

- “retrieving listing identification data from a user” (claim 1)
- “retrieving listing identification data from a user requiring posting of a listing on a network-based commerce system” (claims 13 and 23)
- “retrieving listing data associated with the listing based on the listing identification data” (claims 1, 13, and 23), and
- “generating a listing at least partially based on the listing data” (claims 1, 13, and 23).

Applicant respectfully disagrees. Sherr et al. teaches a user interface for a video rental website (Abstract). A user may search based on a criteria, such as genre, and information about a movie may be displayed (p. 9, paragraph [0088] through [0094]). Nowhere do Sherr et al. disclose the concept of a listing, as claimed in Applicant’s claims 1, 13, and 23, and claims that depend therefrom. Accordingly, Applicant respectfully submits that Sherr et al. do not disclose the above-listed features of Applicant’s claims.

Further, the Office Action rejected claims 1, 3-4, 7-8, 10, 13, 15-16, 19-20, 22-23, 25-26, 29-30, and 32 based only on Sherr et al. The Office Action stated that not all of the recited elements of the claims are found Sherr et al., and more specifically that “Sherr does not explicitly teach the claimed limitation ‘and posting the listing on the network-based commerce system’ ” (rejection of claims 1, 13, 23). The Office Action goes further to state that: “However, Sherr teaches displaying the text list 806 to a user after searching based on user’s input,” and that “[i]t would have been obvious to a person of an ordinary skill in the art at the time the invention was made to apply Barts’ [Applicant assumed the Examiner meant Sherr’s] teaching of displaying the result to a user in order to allow a user [to] view/read a result quickly.”

“Displaying the result to a user” is not the same as the identified missing element of Applicant’s claims of “posting the listing on the network-based commerce system.” Accordingly, the Office Action does not make a viable argument that the Sherr et al. reference teaches or suggests all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Again, the Office Action has identified a missing element from claims 1, 13, and 23 as “posting the listing on the network-based commerce system.” Applicant assumes that the Examiner is taking official notice of the missing element. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of official notice and requests that the Examiner cite references in support of this position. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Claims 3-4, 7-8, 10, 15-16, 19-20, 22, 25-26, 29-30, and 32 depend, directly or indirectly, on claims 1, 13, and 23, respectively, and are patentable over Sherr et al. for the reasons argued above, plus the elements in the claims. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. MPEP § 2143.03.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 1, 3-4, 7-8, 10, 13, 15-16, 19-20, 22-23, 25-26, 29-30, and 32 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 2, 14, and 24 over Sherr et al. in view of Johnson:

In item 7 of the Office Action, claims 2, 14, and 24 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Sherr et al. in view of Johnson. Applicant respectfully traverses the rejection.

The Office Action states that “Sherr discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the

single-reference rejection of claims 1, 13, and 23, Applicant submits that Sherr et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 2, 14, and 24 depend, respectively.

In addition, Applicant submits that the combination of Sherr et al. and Johnson does not produce the subject matter of claims 2, 14, and 24. Accordingly, the Office Action does not make a viable argument that the Sherr et al. and Johnson references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Sherr et al. and Johnson references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 2, 14, and 24 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 5-6, 17-18, and 27-28 over Sherr et al. in view of Porat et al.:

In item 8 of the Office Action, claims 5-6, 17-18, and 27-28 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Sherr et al. in view of Porat et al. (U.S. 2002/0026353). Applicant respectfully traverses the rejection.

First, after the first paragraph of the rejection in item 8, the Office Action refers to Erdelyi, and Porat et al. is not again mentioned. The language used in the specific rejections is substantially the same as the prior rejection of Barts et al. in view of Erdelyi. Further, Porat et al. is not listed on the Notice of References Cited. Accordingly, Applicant is responding to the rejection based on Applicant's assumption that the first paragraph of item 8 identified Porat et al. inadvertently, and that the Examiner's intention was to identify Erdelyi.

The Office Action states that “Sherr discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1, 13, and 23, Applicant submits that Sherr et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 5-6, 17-18, and 27-28 depend, respectively.

In addition, Applicant submits that the combination of Sherr et al. and Erdelyi does not produce the subject matter of claims 5-6, 17-18, and 27-28. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Sherr et al. and Erdelyi references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Sherr et al. and Erdelyi references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 5-6, 17-18, and 27-28 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 9, 21, and 31 over Sherr et al. in view of Barts et al.:

In item 9 of the Office Action, claims 9, 21, and 31 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Sherr et al. in view of Sherr et al. Based on the publication numbers, Applicant believes that the second reference is meant to be Barts et al., and Applicant is responding based on this assumption. Applicant respectfully traverses the rejection over Sherr et al. in view of Barts et al.

The Office Action states that “Sherr discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1, 13, and 23, Applicant submits that Sherr et al. do not disclose the claimed subject matter of claims 1, 13 or 23, from which claims 9, 21, and 31 depend, respectively.

In addition, Applicant submits that the combination of Sherr et al. and Barts et al. does not produce the subject matter of claims 9, 21, and 31. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Sherr et al. and Barts et al. references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Sherr et al. and Barts et al. references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 9, 21, and 31 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Rejection of claims 11-12 and 33-34 over Sherr et al. in view of Ortega et al.:

In item 10 of the Office Action, claims 11-12 and 33-34 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Sherr et al. in view of Ortega et al. Applicant respectfully traverses the rejection.

The Office Action states that “Sherr discloses the claimed limitation subject matter in claim 1”. Applicant respectfully disagrees. As discussed in detail above in response to the single-reference rejection of claims 1 and 23, Applicant submits that Sherr et al. do not disclose

the claimed subject matter of claims 1 or 23, from which claims 11-12 and 33-34 depend, respectively.

In addition, Applicant submits that the combination of Sherr et al. and Ortega et al. does not produce the subject matter of claims 11-12 and 33-34. Accordingly, Applicant further submits that the Office Action does not make a viable argument that the Sherr et al. and Ortega et al. references, when combined, teach or suggest all the claim elements, as is required to make a *prima facie* case of obviousness. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Further, there is not suggestion or motivation given for combining the Sherr et al. and Ortega et al. references. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Applicant respectfully submits that the Office Action has not provided objective evidence for a suggestion or motivation to combine the references.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the above reasons. Accordingly, Applicant respectfully submits that the rejection of claims 11-12 and 33-34 under 35 U.S.C. § 103 has been overcome, and Applicant therefore requests reconsideration and withdrawal of this rejection.

Document Cited but Not Relied upon for this Office Action

Applicant need not respond to the assertion of pertinence stated for the reference Davis et al, (U.S. 5822123), which was cited but not relied upon by the Office Action, since this reference is not made part of the rejections in this Office Action. Applicant is expressly not admitting to this assertion and reserves the right to address the assertion should it form a part of a future rejection.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (480) 538-1735 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date 3 JAN. 2005

By



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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 3 day of January, 2005.

Peter Rebuffoni

Name



Signature